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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/933,715      | 08/22/2001  | Hideaki Takahashi    | SON-2200            | 6288             |

23353 7590 12/29/2006  
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| EXAMINER |
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KESACK, DANIEL

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| ART UNIT | PAPER NUMBER |
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3691

| SHORTENED STATUTORY PERIOD OF RESPONSE | MAIL DATE  | DELIVERY MODE |
|--|------------|---------------|
| 3 MONTHS                               | 12/29/2006 | PAPER         |

**Please find below and/or attached an Office communication concerning this application or proceeding.**

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

|                              |                                      |   |  |
|------------------------------|--------------------------------------|---|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>09/933,715 | <b>Applicant(s)</b><br>TAKAHASHI ET AL. |  |
|                              | <b>Examiner</b><br>Dan Kesack        | <b>Art Unit</b><br>3691                 |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-7,9-12 and 15-17 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7,9-12 and 15-17 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. This Office Action is in response to the amendment filed October 10, 2006. The amendment has been entered and fully considered. Claims 1-7, 9-12, and 15-17 are currently pending. Claims 8, 13 and 14 have been cancelled. The rejections are as stated below.

#### ***Claim Rejections - 35 USC § 112***

2. The rejections of claims 3, 9, 10, 16, and 17 under 35 U.S.C. 112, second paragraph, are withdrawn as a result of Applicant's amendment filed October 10, 2006.

#### ***Claim Rejections - 35 USC § 101***

3. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

4. The rejection of claim 1 under 35 U.S.C. 101 has been withdrawn.

Art Unit: 3691

5. Claim 11 remains rejected under 35 U.S.C. 101 because the claimed invention is directed to a non-statutory subject matter, as cited in the previous Office Action.

***Claim Rejections - 35 USC § 103***

6. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

7. Claims 1-7, 9-12, and 15-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Postrel et al., U.S. Patent No. 6,594,640, in view of Chen, U.S. Patent No. 6,549,912, and further in view of Davis, U.S. Patent No. 6,282,522.

Claims 1 and 11, Postrel teaches the new added claim language of the currently amended claims.

Postrel teaches a user identifier that is used for identifying the user (reward point account – column 5 lines 17-20).

Claims 1 and 11, Postrel fails to teach the identifier is stored in an IC card.

Chen discloses a loyalty file structure for smart cards wherein user identification information relating to a loyalty program is stored on a smart card (figures 3, 4). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Postrel to include storing identification information

Art Unit: 3691

on a smart card because the environment in which Chen implements the disclosed invention is identical to the operational environment of Postrel, and the smart card identification of Chen provides a convenient way for a card holder to identify himself or herself, and convenience is a desirable feature in the current invention.

Claims 1 and 11, Postrel and Chen fail to teach transactions conducted in the virtual world using an IC card.

Davis discloses an internet payment system and method using a smart card, wherein the a user is able to conduct transactions in the virtual world of the internet using an IC card, containing user information (abstract), including reward point programs. It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Postrel and Chen to include the teachings of Davis because Davis teaches the system being used with award points programs over the Internet (column 24 lines 61-67).

### ***Response to Arguments***

8. Applicant's argument with respect to claim 11 under 35 U.S.C. 101 have been fully considered but they are not persuasive.

Examiner contends that according to the method of claim 11, as recited, there is no "useful, concrete, and tangible" result. Converting and managing data does not

Art Unit: 3691

qualify as a concrete and tangible result. Furthermore, while Applicant has amended the claim to recite "privilege information is converted and accorded to the user when the user conducts transactions" does not satisfy this requirement. The language could be given a broad interpretation to constitute no more than manipulating data within a system without producing a concrete or tangible result. Examiner notes that, given its broadest reasonable interpretation, the phrase "accorded to the user" does not require any concrete or tangible output. As such, the rejection of claim 11 under 35 U.S.C. 101 stands.

9. Applicant's arguments with respect to claims 1-7, 9-12, 15-17 under 35 U.S.C. 103(a) have been considered but are moot in view of the new ground(s) of rejection.

In response to Applicant's arguments that Postrel teaches away from Applicant's claimed invention, Examiner respectfully disagrees. Examiner contends that Applicant is relying on limitations which are not recited in the claims, and Applicant's interpretation of the claim language is more limited than Examiner's broadest reasonable interpretation in light of the specification.

Specifically, as cited in the previous Office Action, the invention of Postrel converts the information resulting from a transaction into a number of reward points. While Examiner admits that Postrel allows a user to manually manage reward points in the process of redemption, this is done after the transaction results in an automatic conversion to points. The conversion from transaction to reward points inherently

Art Unit: 3691

occurs according to some formula, and the formula is inherently predetermined in accordance with the teachings of Postrel ("according to the terms of the credit card program" – column 5 line 49).

### ***Conclusion***

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dan Kesack whose telephone number is 571-272-5882. The examiner can normally be reached on M-F, 9:00am-5:00pm.

Art Unit: 3691

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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HANI M. KAZIMI  
PRIMARY EXAMINER